With respect to claims 6 and 8, Roetter and Lewis, alone or in combination, do not address the problem solved by the Applicant's use of a timing signal in the invention. The Applicant's timing signal is related to when to insert a coupon onto or into a container. Roetter's use of a signal is directed only to when the next paper is properly advanced and ready for bursting. Lewis does not have any form of timing signal at all. Lewis cuts coupons and places coupons at regular intervals. In other words, to positively place a coupon on a container, Lewis requires both regularity in spacing between containers and cutting coupons at regular intervals. This approach taught by Lewis would result in the apparatus attempting to place a coupon onto a package even if a package was not present to receive the coupon. Applicant's invention does not suffer from this inefficiency. Applicant's timing signal ensures that a coupon is only inserted when a container is present to receive it. As described in the Applicant's specification, the present invention can be used to positively insert one coupon in each and every container even if the containers are spaced at inconsistent intervals.

Applicant submits that Roetter and Lewis do not teach the Applicant's invention. There is no teaching, suggestion, or incentive supporting the combination of Roetter and Lewis as required to establish obviousness. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). The examiner has not proffered reasons or incentives why one of ordinary skill in the art would combine the teachings of Roetter and Lewis. Moreover, the invention in Roetter is not directed towards the consumer packaging industry. There is no incentive or suggestion by one of ordinary skill in the art of consumer packaging to look toward a burster in the computer industry. "When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why

combination of the reference teachings is proper.... Absent such reasons or incentives the teachings of the references are not combinable." *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd.Pat.App. & Int'f, 1987). This suggestion to combine requirement is a "critical safeguard against hindsight analysis and rote application of the legal test for obviousness." *In re Rouffet*, 149 F.3d. 1350, 1357 (Fed. Cir. 1998).

Accordingly, Applicant believes that the Examiner's §103(a) objections to claims 5-12 should be withdrawn.

CONCLUSION

For the aforementioned reasons, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §103(a) are not well taken and should be withdrawn. Applicant further submits that claims 2-12 are in condition for allowance and respectfully requests the same.

Respectfully submitted,

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